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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VIRGIL ALLEN WATSON and JASON BENDER

Appeal 2010-010297
Application 10/589,012
Technology Center 1700

Before TERRY J. OWENS, PETER F. KRATZ, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 2, 4, 6-13 and 15-19, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The Appellants claim a sign and a method for making a sign.
Claims 2 and 9 are illustrative:

2. A sign for viewing by persons in a traffic area accessible by the random passage of persons through the area, comprising:
a label formed of a flexible thermoplastic substrate upon which the subject matter of the desired sign is printed;
a planar substrate of injected thermoplastic molded material fused to the label; and
wherein the planar substrate includes a mounting feature adapted to secure the sign to a second object;
wherein the second object is a second sign and wherein the mounting feature secures the first sign to a back side of the second sign located opposite from the label.
9. A method of manufacturing a sign, comprising:
providing a first and second sign mold portion located opposite from one another;
associating an injection device with the first sign mold portion;
associating an ejector system with the first sign mold portion;
placing a label in the second sign mold portion;
closing the first and second sign mold portions together; and
injecting the first sign mold portion via the injection device; and
removing a previously formed sign from the first sign mold portion via the ejector system prior to closing the mold portions together
wherein the ejector system contacts the formed sign on a side opposite from the label.

The References

Wardle	4,137,657	Feb. 6, 1979
Hellmer	4,397,625	Aug. 9, 1983
Weiner	4,541,190	Sep. 17, 1985
Hasl	4,880,368	Nov. 14, 1989
Abrams	5,800,757	Sep. 1, 1998
Assalita	5,922,367	Jul. 13, 1999

Eberle	6,131,320	Oct. 17, 2000
Bowers	US 2003/0154639 A1	Aug. 21, 2003
Alberts	WO 03/016017 A1	Feb. 27, 2003

The Rejections

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 2 and 4 over Abrams, claim 6 over Abrams in view of Eberle or Weiner, claim 7 over Abrams in view of Bowers, claim 8 over Abrams in view of Bowers and Wardle, claims 9-12, 15 and 19 over Alberts in view of Abrams, claim 13 over Alberts in view of Abrams and Assalita, claim 16 over Alberts in view of Abrams and Hasl, and claims 17 and 18 over Alberts in view of Abrams, Hasl and Hellmer.

OPINION

The rejections are reversed as to claims 2, 4 and 6-8 and affirmed as to claims 9-13 and 15-19.

Claims 2, 4 and 6-8

We need to address only claim 2, which is the sole independent claim among claims 2, 4 and 6-8, and claim 7.¹

Claim 2 requires a mounting feature which secures a first sign to the back side of a second sign.²

Abrams discloses, in one embodiment, a plastic sheet or film integrally molded into the surface of a part (col. 17, ll. 22-39; Fig. 17). The part can be a basketball backboard (col. 18, l. 61 – col. 19, l. 4). The

¹ The Examiner does not rely upon Eberle or Weiner for any disclosure that remedies the deficiency in Abrams as to claim 2, and does not rely upon Wardle for any disclosure that remedies the deficiency in Abrams and Bowers as to claim 7 (Ans. 5-7).

² The claim 2 embodiment is shown in the Appellants' Figure 3.

backboard can have holes therethrough for mounting it to a frame or pole using fasteners such as bolts (col. 19, ll. 10-14; col. 20, ll. 26-30; Fig. 18). In another embodiment the part is a point-of-purchase display or sign which is not disclosed as being attached to anything (col. 20, ll. 33-34; Fig. 21).

The Examiner argues that “[s]ince it is well-known in the marketing industry to use two-sided point of use promotion signs to attract customers from two directions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect the promotional sign of Abrams to another promotional sign in order to attract customers from two directions” (Ans. 4-5).

“A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). The Examiner has not established that even if it was well known in the marketing industry to use two-sided point of use promotion signs to attract customers from two directions, Abrams’ disclosure in one embodiment of attaching a basketball backboard to a frame or post and disclosure in another embodiment of a sign which is not disclosed as being attached to anything would have suggested attaching a first sign to the back side of a second sign.

The Examiner argues that “the sign of Abrams would be expected to be capable of being mounted to a second sign” (Ans. 5).

Establishing a prima facie case of obviousness requires setting forth not merely the expectation of capability argued by the Examiner but also an apparent reason to carry out the Examiner’s proposed modification of the prior art. *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). The

Examiner has not established that Abrams would have provided one of ordinary skill in the art with an apparent reason to attach a first sign to the back side of a second sign. The record indicates that the Examiner's reason for doing so comes solely from the Appellants' disclosure and that, therefore, the Examiner used impermissible hindsight in rejecting the Appellants' claims 2, 4, 6 and 8.

Claim 7, which depends from claim 2, requires that "the mounting feature secures the first sign to the end of the second sign so that the labels of the first and second signs are contiguous."³

Bowers discloses side-by-side signs connected by cleat-shaped connectors (§ 0033; Fig. 7).

The Examiner argues that "[i]t would have been obvious to a person having ordinary skill in the art at the time the invention was made to connect the signs end to end as taught by Bowers et al. in the method of Abrams for the purpose of increasing the customizability of the sign and allow for more diverse messages to be displayed to attract or inform persons" (Ans. 6).

The Examiner has not established that Bowers would have suggested modifying Abrams so that the first and second signs are attached end-to-end such that the first sign is secured to the back side of the second sign as required by claim 2 from which claim 7 depends. Hence, the Examiner has not established a prima facie case of obviousness of the sign claimed in the Appellants' claim 7.

³ The claim 7 embodiment is shown in the Appellants' Figure 4.

Claims 9-13 and 15-19

Claim 9, which is the sole independent claims among claims 9-13 and 15-19, requires that “the ejector system contacts the formed sign on a side opposite from the label.”⁴

Alberts discloses in one embodiment that “[w]hen, with the aid of the piston /cylinder assembly 36, the first transfer part 38 is moved towards the product 48, this product 48 is engaged with the vacuum means 54 such that upon retraction, it can be taken from the mold cavity 14 with the first transfer part 38” (p. 7, ll. 17-21). In that embodiment (as correctly pointed out by the Appellants (Br. 7)) the vacuum cups (56) engage the label (60) side of the product (48) (Fig. 5). However, Alberts also discloses that “[o]ptionally, ejection means (not shown) can be provided in the mold cavity 14” (p. 7, ll. 21-22) and that “[w]ith such ejection means, the advantage is achieved that the product 48 can be taken out in a simpler manner without the product 48 sustaining damage” (p. 23-25). The “ejection means can be provided for removing products from the mold cavities 14, for instance conventional ejection pins, the product then falling from the mold 2 under the influence of gravity” (p. 12, ll. 9-11). As shown in Alberts’ Figure 5, for the ejection pins to contact the part (48) such that it falls by gravity, the ejection pins must contact the part (48) on its side opposite the side which is contacted in the alternative embodiment by vacuum cups (56), i.e., the ejection pins must contact the part on its side opposite from the label (60) as required by the Appellants’ claim 9.

⁴ The Appellants do not separately argue dependent claims 10-13 and 15-19 (Br. 7-8; Reply Br. 6). We therefore limit our discussion to independent claim 9. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that Alberts' Figure 6 shows a mold cavity (14) on each side of a transfer device (4), but is silent as to the side on which the ejection device is located (Reply Br. 6). The Appellants argue that Alberts "does not explicitly teach or require an ejector system which contacts a formed sign on a side opposite from a label as required by claim 9." (Reply Br. 6).

Alberts indicates that the Figure 6 embodiment relied upon by the Appellants is an alternative embodiment to that shown in Figure 5 (p. 8, ll. 28-29). Unlike the embodiment in Figure 5 which has one mold cavity, the embodiment in Figure 6 has two mold cavities (p. 8, ll. 28-30). Alberts' Figure 8 embodiment has four mold cavities (p. 9, ll. 22-25). Alberts does not indicate that there is only one ejection device for multiple mold cavities. Instead, Alberts' Figure 5 embodiment indicates that there is one ejection device for each mold cavity. As pointed out above, that ejection device contacts the part (48) on its side opposite the label (60) as required by the Appellants' claim 9.

Thus, we are not persuaded of reversible error in the rejection of claims 9-13 and 15-19.

DECISION/ORDER

The rejections under 35 U.S.C. § 103 of claims 2 and 4 over Abrams, claim 6 over Abrams in view of Eberle or Weiner, claim 7 over Abrams in view of Bowers, and claim 8 over Abrams in view of Bowers and Wardle are reversed. The rejections under 35 U.S.C. § 103 of claims 9-12, 15 and 19 over Alberts in view of Abrams, claim 13 over Alberts in view of Abrams and Assalita, claim 16 over Alberts in view of Abrams and Hasl,

and claims 17 and 18 over Alberts in view of Abrams, Hasl and Hellmer are affirmed.

It is ordered that the Examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

tc